

REMARKS**A. Election/Restriction**

In the instant Office Action, the Examiner has required an Election/Restriction, alleging that four patentably distinct inventions are present in pending claims 5, 6, and 29-45. Specifically, the Examiner has indicated that claims 5, 6, 29, 34 and 41 (Examiner's Invention I) are distinct from claims 30, 31, 35, 36, 42 and 43 (Examiner's Invention II), which are distinct from claims 33, 38, 40 and 45 (Examiner's Invention III), which are distinct from claims 32, 37, 39 and 44 (Examiner's Invention IV). The Applicants provisionally elect, with traverse, the alleged Invention I (Claims 5, 6, 29, 34 and 41). For the reasons stated below, Applicants respectfully assert that the Examiner's Election/Restriction is misplaced and should be withdrawn.

B. The Examiner has Failed to Make a *Prima Facie* Case for Election/Restriction

A proper application of a Election/Restriction requires that the Examiner make a *prima facie* case that i) the inventions are independent or distinct as claimed, and ii) the search and examination of the entire application creates a serious burden on the Examiner. See MPEP §803. "Examiners must provide reasons and/or examples to support conclusions...." *Id.* The Examiner has failed to provide reasons as to why the examination would create a serious burden on the Examiner. As the Examiner has failed to comply with the requirements of the MPEP as to proper application of Election/Restriction, Applicants respectfully request that the Election/Restriction be reconsidered and withdrawn.

C. Summary of the Examiner's Examination of the Instant Claims

Throughout prosecution of the instant application, the Examiner has continually examined all of the claims of Inventions I-IV together. As recently as the last Office Action, dated June 15, 2004, the Examiner placed a §102(b) rejection against all of the Examiner's alleged "Inventions" together without distinguishing the claims' limitations. See, Office Action, dated June 15, 2004, page 6 ("Claims 1-4, 17-22 and 25-45 are

rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa”); *See also*, Office Action, dated October 22, 2003 at page 2 (“Claims 1-4, 17-22 and 25-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa”).

The Examiner has examined all pending claims (Inventions I-IV) twice prior to issuing the instant Election/Restriction. Applicants submit that the Examiner has had ample opportunity to search and examine the instant claims on the merits, and has never even hinted that such examination was made with serious burden. As examination can be (and has twice been) made without serious burden; the Examiner must now also examine the claims on the merits. *See MPEP* §803 (“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits...”).

It is telling that the Examiner does not even attempt to explain why a third examination of the same claims on the merits would only now place some additional burden on the Examiner.

Consequently, Applicants respectfully request the withdrawal of the current Election/Restriction.

D. A *Prima Facie* Case for “Independent” Restriction has not been Established

The Examiner makes no statements alleging that the claimed inventions are “independent.” However, even if the Examiner had intended to impose the restriction based on “independent” inventions, the *prima facie* burden has still not been met. Applicants respectfully point out that “independent” inventions, as defined in restriction practice, are “not connected in design, operation, or effect, *MPEP* §§802.01, 808.01, and are “not capable of use together.” *MPEP* §§808.01, 806.04. An example of “independent” inventions would be claims directed to both “a necktie and a locomotive bearing.” *See MPEP* §808.01 at Examiner Note 1; *see also*, *MPEP* §806.04 (“a shoe, and a locomotive bearing”). Clearly, where all currently claimed embodiments of the present invention are related to methods “for selling a product to a customer based on a flexible product description provided by the customer,” no such independence exists.

E. A *Prima Facie* Case for “Distinct” Restriction has not been Established

Alternatively, even if the Examiner had intended to impose the restriction based on “distinct” inventions, the *prima facie* burden has still not been met.

The Examiner has classified “inventions” I and II in class 705, subclass 26, “invention” III in class 705, subclass 5, and “invention” IV in class 705, subclass 14. The Examiner has failed to show the inventions are “distinct” at least for the reason that the Examiner has classified “inventions” I and II together.

As required, the Examiner has failed to show that (1) that each claimed invention “has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search,” (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. See MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the “distinct” theory is established. Where “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” *Id.*

Applicants assert that the Examiner has mischaracterized the claims, and as such, the claims do not “form separate subjects for inventive effort,” nor that a “different field of search is required” (as the Examiner has already searched regarding the instant claims).

Specifically, as stated above, the Examiner has classified “inventions” I and II identically. Further, for purposes of example, claim 32 (Examiner’s Invention IV) contains limitations similar to that of claims 30 (Examiner’s Group II) and 33 (Examiner’s Group III): *a determining step to determine a sale price based on a product description, wherein the customer is not guaranteed what specific product will be purchased before the agreement is received (after receiving the agreement, a selecting step to select a flight on which the airline ticket will allow the customer to travel).*

Consequently, Applicants assert that the “inventions,” as indicated, are not “distinct” and as such, do not require Restriction.

F. The Examiner has Failed to Establish an Undue Burden

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper “[i]f the search and examination of [the] entire application can be made without serious burden.” MPEP §803. Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists as the instant claims have already been examined together twice. In particular, the Examiner has failed to show that (1) separate classification of the alleged species that would necessitate a separate field of search; (2) the alleged species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged species are not related to any class of invention which has achieved a separate status in the art. *See, MPEP* §808.02.

In general, Applicants believe that the claims all can (and twice already have been) readily searched and examined together without undue burden on the Examiner. Indeed, as mentioned *supra*, such a non-burdening search has already been conducted. Thus, without further showing of an undue burden upon the Examiner, Applicants respectfully assert that the Examiner has failed to meet all of the requirements of the MPEP to make a proper Election/Restriction of the instant claims.

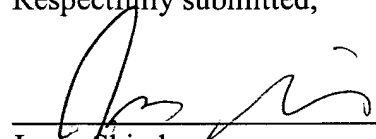
CONCLUSION

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this response or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at jskinder@walkerdigital.com.

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Date

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